

Application No.: 10/817,562

Docket No.: 64671-0523

REMARKS

This amendment is intended to be fully responsive to the Office Action dated November 21, 2005 wherein 1, 4-13 and 16-33 are rejected. In consequence thereof, claims 1, 8-11, 13, 19, 20, 22-24 and 30 have been amended. Claims 7 and 18 have been canceled. Claims 2, 3, 14 and 15 have been previously canceled. Applicants submit that no new matter has been added by this amendment and that support for the amendment may be found throughout the specification and drawings.

35 U.S.C. §112

Claims 1, 4-13, 16-22 and 24-33 are rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1, 13 and 23 have been amended to more clearly articulate aspects of the invention. Applicants respectfully request reconsideration in view of the amendments.

35 U.S.C. § 102

Claims 1, 4-6, 13, 16-17 and 22-33 are rejected under 35 U.S.C. § 102(b) as being anticipated by *Williams*, U.S. Patent No. 6,276,623. Applicants respectfully traverse this rejection.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). See M.P.E.P. § 2131. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03.

Amended claim 1 recites, "A payout tube for a storage container, the payout tube comprising: an elongated conduit with a flexible portion placed in an interior of the container

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and a remaining portion is exterior to the container, said flexible portion including a plurality of independent and discrete slots.” Amended independent claims 13, 22, 23, 24 and 30 are apparatus and method claims that recite, among other things, limitations similar to claim 1.

Williams discloses embodiments of a solder support and dispensing device for preventing the jamming of solder during the dispensing thereof. The device includes a flexible tubular guide member having first and second open ends adapted to receive solder therethrough to prevent jamming of the solder during dispensing thereof. (See Abstract) There is no disclosure or teaching in *Williams* with regard to a payout tube comprising an elongated conduit with a flexible portion being placed in an interior of the container and a remaining portion being exterior to the container, said flexible portion including a plurality of independent and discrete slots. Contrarily, *Williams* does not provide any disclosure of the flexible tubular guide member having slots. Although the difference between the prior art and present application may be slight, it is erroneous to require the patentee to show a “remarkable degree of difference,” because this minor difference may have been the key to success. Jones v. Hardy, 727 F.2d 1524 (Fed. Cir. 1984). *Williams* does not provide any disclosure or suggestion of the flexible tubular guide member having a plurality of independent and discrete slots. Accordingly, for at least these reasons, independent claims 1, 13, 22, 23, 24 and 30 embody patentable subject matter and it is respectfully requested that these claims, as well as their respective dependent claims, be passed to issue.

35 U.S.C. §103

Claims 7-12 and 18-21 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Williams* in view of *Redford* (U.S. 5,031,982). Applicants respectfully traverse this rejection.

The remarks set forth above with regard to the patentability of independent claims 1, 13, 22, 23, 24 and 30 are equally as applicable here. *Redford* is relied on to cure the deficiencies of *Williams*, particularly with regard to teaching a payout tube having a flexible portion made up of slots and corrugations. Applicants respectfully disagree.

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Redford teaches, "a flexible duct through which a dispensed optical fiber passes upon missile launch is formed by helically winding a filament such as a spring wire forming an elongated tube-like member" (Col. 1, Ins. 50-55) Applicants submit that *Redford* fails to teach or suggest a device having a plurality of independent and discrete slots and that helically winding spring wire to form a flexible duct would not produce independent and discrete slots as claimed. Accordingly, claims 7-12 and 18-21 are patentable for at least this reason.

CONCLUSION

For at least the above reasons, this application is believed to be in condition for allowance. Accordingly, it is respectfully requested that this application be passed to issue.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-0013, under Order No. 64671-0523 from which the undersigned is authorized to draw.

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Respectfully submitted,

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